

REMARKS

I. Formal Matters

Claims 1, 2, 4, 9-11, 17, 23 and 27-37 are all the claims pending in the present Application. By this Amendment, Applicant amends claims 17, 32, 36 and 37. The Amendments to claims 17, 32, 36 and 37 were made for reasons of clarity and precision of language. These amendments were not made for reasons of patentability.

II. Claim Rejections Under 35 U.S.C. § 112

The Examiner has rejected claims 27-29 and 31 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that the amended limitation: “wherein said additional personal information of the specific user matches categories, wherein said categories are common to a group of users,” does not appear to have support in the original disclosure. Applicant respectfully disagrees.

In one exemplary embodiment of the present invention, the user provides the system with personal information when sending correction data, such as the users’ age, sex or residence area. (See e.g., page 14, lines 15-17). Categories, such as for example, age, are **common** to all users. In other words, every user has an “age” associated with him or her. In fact, the Examiner relies on the very same categories (age, sex and residence), as allegedly corresponding to “categories being common to a group of users,” in his rejection of these claims under 35 U.S.C. § 103. (See Office Action, pages 15-16). For at least the above reasons, Applicant respectfully asserts that claims 27-29 and 31 are properly supported throughout the specification.

Additionally, the Examiner has rejected claims 17 and 23 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 17, this claim

has been amended to correct the antecedent basis as requested by the Examiner. Applicant submits that the correct Amendment to claim 17 was inadvertently omitted from the previous response. With regard to claim 23, this claim has been canceled. As such, Applicant respectfully asserts that the rejection of claims 17 and 23 is now moot.

III. Claim Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 9 and 23 under 35 U.S.C. § 102(e) as allegedly being anticipated by Berger et al. (U.S. Patent 6,414,693). Applicant respectfully disagrees.

With regard to independent claim 9, Berger fails to teach, or even suggest, at least “an information entry selecting means allowing a user to, **enter design information without downloading public design data**, or request transfer of said public design data from the design data publicizing processing unit to the user together with an editing program file.”

The Examiner asserts that Berger discloses (1) “additional instruction dialog boxes [that] can appear ... following a submission of a custom design by the client to provide more specific instructions for producing an actual, physical version of the article,” and (2) “[a] variety of dialog boxes ... provided to facilitate on-line ordering of submitted bags according to current, widely employed principles of e-commerce.” The Examiner asserts that these statements taken together mean that: “[i]n other words, other than downloading the public design data, a client may use the additional instruction dialog boxes to provide data, e.g., correction data.” (See Office Action, page 20). This is simply incorrect.

Both of the Examiner statements, statements (1) and (2) refer to actions taken **after** the public design data has been downloaded. For example, the Examiner’s first statement, statement (1), plainly states that the “additional dialog boxes” appear **following a submission of custom design** by the client. In other words, the client must first download public design data, design his

product, and only **after** the client submits his design for production, can the additional dialog boxes appear, “to provide more specific instructions for producing an **actual, physical** version of the article.”

Similarly, with regard to the Examiner’s second statement, statement (2) plainly states that the “variety of dialog boxes” are provided to facilitate on-line ordering of **submitted** bags. That is, **the bags have already been designed and submitted** and the dialog boxes are used to **order** the bag. In other words, statement (2) is not related to providing **correction data** for a design, but instead, simply involves ordering a bag **which has already been designed**.

For at least the above reasons, Applicant respectfully asserts that claim 9 is allowable over the cited art of record.

With respect to claim 23, this claim has been canceled. As such, Applicant respectfully asserts that this rejection is now moot.

IV. **Claim Rejections Under 35 U.S.C. § 103**

The Examiner has rejected claims 1, 2, 4, 10, 11, 17, 27-31 and 35-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berger, in view of Goldstein (U.S. Patent Publication No. 2001/0032115). Applicant respectfully disagrees.

With regard to claim 1, neither Berger, nor Goldstein, alone or in combination, teach or suggest, at least “said received submission processing unit **classifying said attached correction data** based on the additional personal information of the specific user recited in said received electronic submission **and registering said correction data in said data base based on the classification results.**”

The Examiner has conceded that Berger fails to teach the above-mentioned claim limitation. However, the Examiner relies on Goldstein in attempting to cure the deficient disclosure of Berger. Applicant respectfully disagrees.

Goldstein cannot cure the deficient disclosure of Berger, because Goldstein also fails to teach the above-mentioned limitation of claim 1. That is, Goldstein is simply directed to organizing personal information of a plurality of users according to a set category. Goldstein, however, does not teach, or even suggest, “**classifying said attached correction data** based on the additional personal information.” In fact, Goldstein does not teach associating *any* data with the personal information of the user.

Furthermore, in Goldstein, each user enters personal information to be included in the user’s profile. This personal information in Goldstein can be sorted according to the various types of personal information entered by the user. Similarly, in Berger the user creates a profile with which to access his or her own data. Thus, to the extent the Examiner is combining Berger with Goldstein, the result would simply be a user, with a profile which includes personal information. There is simply no teaching in either Berger, or Goldstein, of classifying any data based on the personal information of the user.

Additionally, Berger is directed to providing an outlet that allows a user to create a custom handbag. For this purpose, the user creates a profile, designs the bag based on his own needs, and submits the designed bag to the manufacturer for production and delivery. As such, there is no motivation to classify the custom handbag order according to the personal information of the user. Instead, all that is required of the Berger system is for each user to be associated with that user’s order. Any further association (such as the custom bag order with the personal

data of the user) would be a waste of storage space, and unnecessary for the purpose Berger is directed to. As such, Berger teaches away from the combination proposed by the Examiner.

For at least the above reasons, Applicant respectfully asserts that claim 1 is allowable over the cited art of record.

With regard to claims 2, 4, 10, 27, 28 and 35 these claims depend from independent claim 1. As such, Applicant respectfully asserts that these claims are allowable at least by virtue of their dependency from claim 1.

Applicant's independent claim 11 is a method claim and is distinguished over Berger for reasons analogous to those recited for claim 1. Further, claims 29, 30 and 36 depend from independent claim 11 and are therefore allowable at least by virtue of their dependency on claim 11.

Applicant's independent claim 17 is an apparatus claim and is distinguished over Berger for reasons analogous to those recited with respect to claim 1. With regard to claims 31 and 37, these claims depend from independent claim 17. As such, Applicant respectfully asserts that claims 31 and 37 are allowable at least by virtue of their dependency from claim 17.

With regard to claims 32-34, the Examiner has rejected these claims under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berger, in view of Goldstein. Applicant respectfully disagrees.


Claims 32-34 depend from independent claims 1, 11 and 17 respectively. As such, Applicant respectfully asserts that claims 32-34 are allowable at least by virtue of their respective dependencies.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

This Application is being filed via the USPTO Electronic Filing System (EFS). Applicants herewith petition the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



John F. Rabena
Registration No. 38,584

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 25, 2007